

REMARKS

I. Claim Status

Claims 11-26 are pending.

Claims 9 and 10 have been canceled.

Claims 11 and 12 have been amended.

Claims 14-26 are new.

II. Claim Rejection Under 35 U.S.C. § 112

Claims 11-16 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, these claims had dependencies to claims that were withdrawn and claims that were not composition claims. Applicants have amended claims 11 and 12 to correct their dependency. Specifically, claims 11 and 12 now depend from new claim 14 and claim 13 remains dependent upon claim 12. In view of amendments to claims 11 and 12, Applicant respectfully request that this rejection be withdrawn.

III. Claim Rejections Under 35 U.S.C. § 103(a)

The Office Action rejected claims 9-12 under 35 U.S.C. § 103(a) as being obvious in view of Kyle et al. According to the Office Action, Kyle et al. disclose "proline compounds (intermediates) (see column 6, lines 34-44 and column 20, lines 35-61)" used to make bradykinin antagonist peptides.

Applicant respectfully submits that the Office Action has not made out a *prima facie* case of obviousness and therefore the claims of the invention are patentable over Kyle et al. The genera of compounds disclosed at column 6, lines 34-44 and column 20, lines 35-61 are process intermediates and are not described as bradykinin antagonists. Therefore, Kyle et al. cannot be relied upon to teach or suggest making the compounds claimed in the present application which are alpha-2-delta ligands. See *In re Jean Pierre Lalu and Louis Foulletier*, 747 F.2d 703, 707 (Fed. Cir. 1984), which is cited in the *Manual of Patent Examining Procedure*, § 2144.09 (8th ed, Feb. 2003).

In *Lalu*, the U.S. Court of Appeals for the Federal Circuit reversed a Board of Appeals decision that the claims at issue were *prima facie* obvious in view of a prior patent to Oesterling, which disclosed structurally similar compounds (sulfonyl chlorides) that were process intermediates. The Court in *Lalu* concluded that:

There is not disclosure that the Oesterling compounds would have any properties in common with those of appellants' compounds, as those properties of the former relate to the use of the compounds for base neutralization, catalysis, metal cleaning, and fuel. The mere fact that Oesterling's sulfonyl chlorides can be used as intermediates in the production of the corresponding sulfonic acids does not provide adequate motivation for one of ordinary skill in the art to stop the Oesterling synthesis and investigate the intermediate sulfonyl chlorides with an expectation of arriving at appellants' claimed sulfonyl halides for use as corrosion inhibiting agents, surface active agents, or leveling agents.

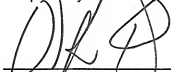
Lalu at 707. Here, Kyle et al. describe certain bradykinin peptide derivates and analogs, which may serve as bradykinin antagonists. Like *Lalu*, the proline intermediates of Kyle et al., which form the basis of the obviousness rejection, are process intermediates in the preparation of the bradykinin derivatives. Nothing in Kyle et al. indicates that the proline intermediates are themselves bradykinin antagonists. Therefore, Applicant respectfully submits that the claims of the present application are not *prima facie* obvious in view of Kyle et al. Applicants respectfully request reconsideration and withdrawal of this rejection.

IV. Conclusion

In view of the amendments and remarks made above Applicants believe that this application is now in condition for allowance. Reconsideration and allowance of claims 11-26 is respectfully requested.

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Respectfully submitted,



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